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10/524,236

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Matthias Heinrich

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HOFFMANN & BARON, LLP
6900 JERICHO TURNPIKE
SYOSSET, NY 11791

EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/524,236 | Applicant(s) HEINRICH ET AL. | |
| | Examiner ALICIA CHEVALIER | Art Unit 1794 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-28 is/are pending in the application.
- 4a) Of the above claim(s) 20-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-19 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

RESPONSE TO AMENDMENT

1. Claim 1 and 3-28 are pending in the application, claims 20-27 are withdrawn from consideration. Claim 2 has been cancelled.
2. Amendments to the claims, filed on December 8, 2008, have been entered in the above-identified application.

WITHDRAWN REJECTIONS

3. The 35 U.S.C. §112 rejections of claims 1-19, made of record in the office action mailed August 6, 2008, page 3, paragraph #7 have been withdrawn due to Applicant's amendments in the response filed December 8, 2008.
4. The 35 U.S.C. §102 rejections of claims 1-19 and 28 over Chatwin et al. (US Patent No. 5,310,222) and Stump et al. (US Patent No. 5,835,271, made of record in the office action mailed August 6, 2008, pages 4-7, paragraphs #10 and #11 has been withdrawn due to Applicant's amendments in the response filed December 8, 2008.

REJECTIONS

5. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

Drawings

6. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the masking layer, desired-fracture locations and window shaped regions must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

7. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character “37” has been used to designate both reflection layer and masking lacquer layer. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet

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should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

8. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: structure layer 84. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

9. Claims 5, 9-12, 15 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 5 recites “masking layer” which is unclear and renders the claims vague and indefinite. It is unclear if the masking layer is the intermediate layer or a separate layer. The only discussion of “masking” in the specification is on page 15, line 30 through page 16, line 15, where it recites “The intermediate layer 55 is formed by a masking layer.” It is also unclear if the masking layer is in the final product or just used in the process of making the intermediate layer.

The phrase “desired-fracture locations” in claims 9 and 12 is unclear and renders the claims vague and indefinite. It is unclear what constitutes a fracture location, e.g. a hole, gap, a single point in the film, etc.

The term “limit value” in claim 9 is unclear and renders the claims vague and indefinite. It unclear what value is claimed and what the limit is and/or what exceeds it.

Claim 11 recites “in which the structure layer has been broken up,” which is unclear and renders the claims vague and indefinite. It is unclear if the structure layer is physically being broke” up, which the examiner cannot find support in the specification for, or if the structure layer is broken up by a discontinuous intermediate layer.

Claim 15 recites “wherein the reflection layer is removed in a window-shaped region,” which is unclear and renders the claims vague and indefinite. It is unclear where this window-shape region removed from.

10. Claim 28 provides for the use of a multi-layer film, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 28 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966). Claim 28 is directed to a **method of using** a multi-layer film and Applicant's amendments to claim 28 are directed to the method/process of making the multi-layer film, not to the method/process of using the film.

Claim Rejections - 35 USC § 102

11. Claims 1 and 3-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Reinhart (U.S. Patent No. 5,714,231).

Regarding Applicant's claim 1, Reinhart discloses a multi-layer film comprising a transparent structure layer (*top portions of transparent cover lacquer layer, col. 3, line 4 and the figure*) and a reflection layer (*reflecting metal layer, col. 4, line 26*) arranged beneath the structure layer in the viewing direction (*the figure*). The transparent structure layer includes a spatial structure (*col. 5, line 13*) which is deemed to produce an optically perceptible effect. The optically perceptible effect of the spatial structure is deemed to be not optically perceptible in a pattern configuration by means of an intermediate layer (*decorative lacquer layer, col. 4, line 30*) which is shaped in the form of a pattern and which is arranged between the structure layer and the reflection layer (*the figure*).

Claim 1 recites "the optically perceptible effect of the spatial structure is not optically perceptible in a pattern configuration by means of ***at least one of***". Therefore, the limitation of

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“an absence in a pattern configuration of the reflection layer ...” is an optional limitation and does not need to be present to anticipate the claim.

The preamble “for the production of a decorated article which has a base body decorated with the multi-layer film and having curved surface regions” is deemed to be a statement with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a *structural difference* between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. MPEP § 2111.02. The limitation “the multi-layer film is deformable in production of the decorated article to match a curvature of the base body of the decorated article” further limits the intended use of the multi-layer film and is therefore also not further limiting in so far as the structure of the product is concerned.

Regarding Applicant’s claims 3, 4, 6 and 8, Reinhart discloses that the intermediate layer comprises one or more lacquer layers which comprise a transparent material and which level the structure of the structure layer in a pattern configuration and/or an opaque material (*col. 4, lines 20-25 and col. 3, lines 8-13*). The intermediate layer comprises a thermoplastic material (*col. 5, lines 31-44*) and can be colored (*col. 3, lines 8-13*).

Regarding Applicant’s claim 5, the limitation “wherein the intermediate layer has a masking layer which is partially removable with a portion of the reflection layer” is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art.

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MPEP 2113. Furthermore, it has been held that the recitation that an element is “capable of,” i.e. removable, performing a function is not a positive limitations but only requires the ability to so perform.

Regarding Applicant’s claim 7, Reinhart discloses that the flexibility of the intermediate layer is different from that of the structure layer, since they are made from different materials and thicknesses (*col. 5, lines 17-44*).

Regarding Applicant’s claims 9-12, Reinhart discloses that the structure layer and reflection layer have desired-fracture locations (*gaps in the intermediate layer, the figure*) so that the structure layer breaks up in a defined fashion. The desired-fracture locations are so arranged that optically perceptible effect of the spatial structure is not impaired by the fracture of the structure layer in the region of the desired-fracture locations and the optically perceptible effect of the spatial structure is no longer produced in regions in which the structure layer has broken up (*the figure*).

The limitation “in regions in which a curvature of the structure layer in a curved surface region exceeds a limit value” further limits the intended use of the multi-layer film and is therefore also not further limiting in so far as the structure of the product is concerned.

Regarding Applicant’s claims 13-15, Reinhart discloses that the film comprises a layer with a higher refractive index and thermally insulating properties (*decorative lacquer layer*) than the structure layer is arranged between the structure layer and the reflection layer (*col. 4, lines 55-57 and col. 5, lines 31-44*). Furthermore, the reflection layer is removed in a window-shaped region on the structure layer (*the figure*).

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Regarding Applicant's claim 16, Reinhart discloses the structure layer comprises a thermoplastic material into which the spatial structure is embossed (*col. 4, lines 12-13 and col. 5, lines 18-30*).

Regarding Applicant's claims 17 and 18, Reinhart discloses that the structure has a visible structure which does not have an optical-diffraction effect with a roughness depth of the order of magnitude of between 0.8 and 10 μm (*col. 5, lines 17-20*).

Regarding Applicant's claim 19, Reinhart discloses that the reflection layer is a metal layer, a layer comprising a metal oxide or a metal sulfide, or a layer comprising a reflective plastic material (*col. 4, lines 26-30*).

ANSWERS TO APPLICANT'S ARGUMENTS

12. Applicant's arguments in the response filed December 8, 2008 regarding the previous rejections of record have been considered but are moot since the rejections have been withdrawn.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Alicia Chevalier/
Primary Examiner, Art Unit 1794
3/19/2009